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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|---------------------|
| 10/707,921 | 01/26/2004 | Onje' Erfan | ERF 1125 | 1920 |
| 26092 | 7590 | 04/06/2006 | EXAMINER | |
| KYLE W. ROST 5490 AUTUMN CT. GREENWOOD VILLAGE, CO 80111 | | | | FAULCON JR, LENWOOD |
| | | ART UNIT | | PAPER NUMBER |
| | | | | 3762 |

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|----------------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/707,921 | ERFAN, ONJE' |
| | Examiner Lenwood Faulcon, Jr. | Art Unit 3762 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 06 January 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-16 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed January 6, 2006, have been fully considered but they are not persuasive. However, Applicant's arguments, see pages 7-8, filed January 6, 2006, with respect to claims 1-15 have been fully considered and are persuasive. The 35 USC 102(b) rejection of claims 1-15 has been withdrawn.

In regards to claim 1, Applicant takes the position that the Kim et al. reference teaches of a earpiece that is custom crafted and is thus different from the system as claimed by Applicant; however, Examiner takes the position that the system as taught by Kim et al. still teaches of a device that is inherently capable of providing proper contact with the appropriate treatment points by its very nature of operating. Further, Examiner takes the position that although Kim et al. does not specifically teach of the system being self-administrable, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine this limitation as taught by the Colsen et al. reference (col. 3 lines 6-9), for the purpose of enhancing treatment options.

Applicant also takes the position that the Kim et al. reference teaches of an impedance sensing probe separate is distinct from the treating earpiece electrode; however, Examiner takes the position that the Applicant merely claims that the impedance detector need be in communication with the tissue interface circuit, which is taught by Kim et al (col. 3 lines 45-47). Further, Examiner takes the position that Kim et al. does not necessarily teach that the impedance detecting probe has to be separate from the treating electrode portion, and actually suggests the impedance probe could be

part of the treating electrode portion since the measurements are also announced by a meter, LED or LCD display or by a sonic annunciator (“professional model”, col. 3 lines 56-66, col. 5 lines 59-67, col. 6 lines 1-2, Figure 3). Examiner interprets the sonic annunciator, as taught by Kim et al. (col. 5 lines 66-67, col. 6 lines 1-2), can provide an audible signal indicating an area of the ear having suitable low impedance. Examiner takes the position that is inherent in the system as taught by Kim et al. that if the electrodes are not in proper placement after being inserted, the electrodes could be adjusted for proper placement (col. 4 lines 60-62, col. 6 lines 3-8).

Applicant takes the position that the protrusion as taught by McCall does not teach of the protrusion as claimed by the Applicant, but rather teaches of a “loose part;” however, Examiner takes the Applicant’s definition of a “loose part” as being irrelevant to the limitations as claimed by the Applicant. Examiner takes the position that the protrusion as taught by McCall is inherently capable of guiding the earpiece’s electrode into contact with a desired area of an ear by its very nature of operation.

2. In response to applicant’s argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., impedance sensing function operating through the same electrodes as the treatment signal, pivot rings, pivot limiting means) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

3. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Kim et al., Colsen et al. and McCall all teach of devices that provide electrical energy to a patient for therapeutic purposes, and thus teach of analogous arts. In regards to the combination of Kim et al. and Colsen et al., Examiner takes the position that the feature of self-administration, as taught by Colsen et al., would enhance the operation of electrically therapeutic devices, including the system as taught by Kim et al. Further, Examiner takes the position that Colsen et al. does treat particular points, acupuncture points (col. 2 lines 59-66), similar to treatment of particular points as taught by Kim et al.; notwithstanding the notion that even if Colsen et al. does not teach of treating points as defined by Kim et al., this would not preclude the motivation to combine the self-administering teaching of Colsen et al. with the teachings of Kim et al., as both systems still rely on treating particular points by electrical stimulation.

In regards to combination

Claim Rejections - 35 USC § 103

4. Claims 1-15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al. (U.S. Patent No. 5,514,175) in view of Colsen et al. (U.S. Patent No.

4,966,164), and further in view of McCall (U.S. Patent No. 4,267,838) as applied in the previous Office Action of October 6, 2005, and as applied above.

5. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al. (U.S. Patent No. 5,514,175) in view of Colsen et al. (U.S. Patent No. 4,966,164), and further in view of McCall (U.S. Patent No. 4,267,838) as applied to claims 1-15 above. Kim et al. teaches of the ability of providing bipolar signals for treatment (col. 3 lines 40-44, col. 6 lines 35-40) and Examiner takes the position that the system is capable of providing a positive waveform signal to one tissue interface circuit and providing a negative waveform signal to the second interface circuit (col. 6 lines 41-46).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Leech (U.S. Patent No. 521,800), Pollard (U.S. Patent No. 1,623,552), Morey (U.S. Patent No. 3,894,532), McCall (U.S. Patent No. 4,450,846), Faltys et al. (U.S. Patent No. 6,826,430).

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lenwood Faulcon, Jr. whose telephone number is 571-272-6090. The examiner can normally be reached on Monday-Thursday from 9 to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela D. Sykes, can be reached on 571-272-4955. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lenwood Faulcon, Jr.



George Manuel

Primary Examiner